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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/621,178

07/16/2003

Douglas S. Horne

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2354

21999

7590

05/23/2008

KIRTON AND MCCONKIE

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SALT LAKE CITY, UT 84111

EXAMINER

HOEKSTRA, JEFFREY GERBEN

ART UNIT

PAPER NUMBER

3736

MAIL DATE

DELIVERY MODE

05/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/621,178	Applicant(s) HORNE ET AL.	
	Examiner JEFFREY G. HOEKSTRA	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-14, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-14, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice of Amendment

1. In response to the amendment filed on 02/13/2008, amendment(s) to the Specification, amended claim(s) 1 and 11, canceled claim(s) 1-6, 15, and 16, and new claim(s) 17 and 18 is/are acknowledged. The current rejections of the claim(s) 7-14 is/are *withdrawn*. The following new and reiterated grounds of rejection are set forth:

Drawings

2. The drawings were received on 02/19/2008. These drawings are unacceptable.

3. The drawings are objected to because (a) Figure 7 contains inappropriate labels for the x-axis lacking a unit of measure, (b) Figures 6-12 contain informal labels of the graphed data (e.g. "Epic", "Manual", "Series 1", and/or "Duane" are not mentioned and/or defined in the Specification), and (c) Figures 6-12 contain a y-axis label without a unit of measure.

4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 7-14, 17, and 18 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. The disclosed invention (i.e. "accurately locating a meridian transdermally and obtaining a value for an electrical attribute corresponding to such a meridian") is not supported by a well established utility and is inoperative.

7. It is well established that the dielectric properties and electrical attributes of skin, conductance and/or impedance for example, are highly inhomogeneous due to the varied physiological and anatomical structures present within the multiple layers of the epidermis, the dermis, and the subcutaneous tissue (see at least pages 6-7 of Miklavcic et al. NPL submitted 05/29/07). Moreover, it is well-known in the art that the electrical attributes corresponding to the varied physiological and anatomical structures of the

skin may be measured and directly expressed as a number of various electrical properties.

8. However, *considerable debate within the scientific community exists whether acupuncture points, acupressure points, and/or meridian lines may be directly measured, expressed as, and/or even associated with the above electrical attributes.*

The Examiner respectfully submits that the disclosed invention is not supported by a well established utility and is inoperative.

9. The Examiner respectfully requests Applicant provide substantiated evidence that the disclosed invention is both (a) supported by a well established utility and (b) is operative.

10. The Examiner reiterates and emphasizes for the record at least the following elements of the instant disclosure that may be considered not supported by a well established utility and inoperative:

- *Specification page 10 reads in part: "A dermal area corresponding to a meridian exhibits higher conductivity and, hence, lower resistivity, than adjacent, non-meridian containing dermal areas. A relatively high conductance value, or low resistance value, may then be used to more accurately isolate a dermal area corresponding to a meridian."*
- *Specification page 11 reads in part: "As a result, one aspect of the present invention is directed to implementing a probe having physical qualities capable of objectively detecting and analyzing electrical signals corresponding to a meridian."*

- *Specification page 11 reads in part: "An electrical signal may comprise a conductance value or a resistance value corresponding to the dermal area. Where a conductance value is obtained from a probe, a meridian may be located where the conductance value is significantly greater than an adjacent dermal area. On the other hand, where a resistance value is obtained, a resistive value significantly less, than an adjacent dermal area may indicate a location of a meridian."*
- *Specification page 12 reads in part: "When the measured conductance value is substantially greater than the previously obtained conductance value, the amount of pressure corresponding to the measured conductance value may be maintained 36 and a meridian signal obtained there from".*
- *Specification page 13 reads in part: "A feedback loop 46,49 and 50 may compare a first detected meridian signal to a second detected meridian signal and compare the relationship between the first and second detected meridian signals to compute and adjust the input that drives the biasing element 48".*

Claim Rejections - 35 USC § 112

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 7-14, 17, and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in

the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The disclosed invention (i.e. “accurately locating a meridian transdermally and obtaining a value for an electrical attribute corresponding to such a meridian”) is not enabled.

13. The Examiner notes that the measured electrical attributes of the skin appear to be conductance in the instant Specification and Applicant appears to correlate increases and decreases in the value of conductance with meridians (see paragraph 10 above). However it is indeterminate how these relationships are established and what scientific basis is relied upon in establishing such relationships between a measured skin conductance and a location or signal of a meridian. Not only does the disclosed invention appear to be unsupported and inoperative, the claimed subject matter does not appear to be described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Requirement for Information - 37 CFR 1.105

14. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

15. An issue of public use and sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows:

16. It has come to the Examiner's attention that both the disclosed and claimed invention appear to have been available for public use and sale activity more than one year prior to the filing date of 07/16/2003.

17. The Examiner respectfully requests Applicant provide a submission detailing and concerning the public use and sale activity of Assignee's products prior to the filing date. Applicant's attention is directed to the Notice of References cited contained herein citing the Assignee's webpage as of 01/20/2002

(<http://web.archive.org/web/20020212132254/www.biomeridian.com/biomeridian.htm>).

18. In response to this requirement, please provide at least the names and corresponding documentation of any products, services, training seminars, etc... that have incorporated the claimed subject matter.

19. Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

Response to Arguments

20. Applicant's arguments, filed 05/29/2007, with respect to claims 7-14, 17, and 18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

21. This Office action has a requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete reply to the attached

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requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY G. HOEKSTRA whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.H./

Jeff Hoekstra

Examiner, Art Unit 3736

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/Max Hindenburg/

Supervisory Patent Examiner, Art Unit 3736